

REMARKS

Entry of this amendment is respectfully requested. Prior to this amendment, Claims 1-10 and 17-63 were pending. As discussed in more detail below, Claims 1, 5-7, 35-36 and 56-63 are amended herein and Claims 47-50 are cancelled herein. The amendments to the claims do not introduce new matter into the specification and are fully supported by the specification as originally filed.

Election/Restrictions

Applicants thank the Examiner for withdrawing the election/restriction requirement.

Claim Rejections - 35 USC § 112

The Examiner rejected Claims 1-10 and 17-46 under 35 U.S.C. 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner contended that:

The instant claims are indefinite for the following reasons:

- (a) *claim 1 (and claims depending therefrom) recites the group "-SO₃-R" but does not define the variable "R";*
- (b) *claims 5-7 and 53-63 recite "any of claim 1", did applicant intend "claim 1" or "claims 1-?" and*
- (c) *claims 35 and 36 lack a period at the end of the instant claims.*

The Examiner further requested that the above mentioned errors be corrected.

Applicants have amended the claims to correct the above errors. In particular, Claim 1 and 5 have been amended to recite that R¹ and R² may be selected from -SO₂-R. Since Claim 1 already recited that R¹ and R² could be -SO₃-R, and a definition for R was inadvertently omitted from Claim 1, Claim 1 was amended to recite that R¹ and R² were selected (in part) from: sulfur so as to form -SO₃-R or -SO₂-R wherein R is selected from H and organic groups having 1-30 carbons optionally containing 1-6 heteroatoms selected from nitrogen, oxygen, phosphorous, silicon and sulfur. This language is consistent with language already in Claim 1,

with reference to R¹ and R² being selected from nitrogen-containing compounds. In addition, support for R¹ and R² being selected from -SO₂-R, and for the definition of R, is found at, e.g., Figures 1A and 1B (and the corresponding discussion at page 36, line 19-21) which not only indicate that -SO₂-R may be bonded to the nitrogen to which R¹ and R² are bonded, but also provides a synthesis for such compounds; pages 20, line 13 and 99, Table 3 which both provide specific examples of compounds of Claim 1 wherein -SO₂-R is bonded to the nitrogen at the 3-position, and page 39, line 23 to page 40, line 2 which provides the definition of R.

Applicants has also corrected Claims 5-7 and 53-63 to recite dependency only upon Claim 1.

Applicants have also corrected Claims 35 and 36 to have a period at the end of each.

In view of these corrections and the above reasons for entering the amendments to Claim 1 and 5, Applicants respectfully request the withdrawal of the above rejection of Claims 1-10 and 17-46 under 35 U.S.C. 112, ¶2.

Claim Rejections: Double Patenting (35 U.S.C. 101)

The Examiner rejected Claims 47-50 under 35 U.S.C. 101 as claiming the same invention as that of claims 10-13 of prior U.S. Patent No. 6,635,629.

Applicants have cancelled Claims 47-50 thereby rendering moot this rejection with respect thereof.

The Examiner also provisionally rejected Claim 52 under 35 U.S.C. 101 as claiming the same invention as that of claim 68 of copending Application No. 10/258,950. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Applicants acknowledge that this is only a provisional rejection and reserve the right

to fully address this issue upon the issuance of the conflicting claims in copending Application No. 10/258,950.

Claim Rejections: Double Patenting (Judicially Created Doctrine)

The Examiner rejected Claims 1-10, 17, 18, 20-46 and 53-55 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,635,629. In particular, the Examiner contends that:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass 3-nitrogen-6,7-dioxygen steroids as defined by the instant claims wherein C17 is substituted as defined by claim 1 of US Patent No. 6,635,629. The claims of the present application differ from the above-mentioned patent in the recitation of additional C17 substituents. However, selection of the C17 substituents recited by the above-mentioned patent would be obvious to one skilled in the art based on the compounds of claims 47-50 of the present application.

Applicants submit herewith a *Terminal Disclaimer to Obviate a Double Patenting Rejection over a "Prior" Patent*, which has been signed by the undersigned attorney of record. Applicants respectfully submit that this terminal disclaimer overcomes the rejection of Claims 1-10, 17, 18, 20-46 and 53-55 under the judicially created doctrine of obviousness-type double patenting as set forth above.

The Examiner also provisionally rejected Claims 1-10, 17-51 and 53-63 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 64-121, 125 and 126 of copending Application No. 10/258,950. In particular, the Examiner contends that:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass 3-nitrogen-6,7-dioxygen steroids as defined by the instant claims wherein R¹ and R² are as defined by claims of copending Application No. 10/258,950. The claims of the present application differ from the above-mentioned application in that they recite additional R¹ and R² groups. However, the selection of the R¹ and R² groups recited by above-mentioned application would be obvious to one skilled in the art based on the compounds of claim 52 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicants acknowledge that this is only a provisional rejection and reserve the right to fully address this issue upon the issuance of the conflicting claims in copending Application No. 10/258,950.

In view of the foregoing arguments and amendments, Applicants respectfully submit that all of the remaining claims are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
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